

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Fernandez-Pol

Application No. 09/784,631

Filing date: 02/15/2001

For: PHARMACOLOGICAL AGENT
AND METHOD OF TREATMENTAssistant Commissioner for Patents
Washington, D.C. 20231

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SEP - 6 2001

PETITIONS OFFICE

PETITION UNDER 37 C.F.R. §1.47 (b)

Dear Sir:

Under 37 C.F.R. §1.47(b), whenever all of the inventors refuse to execute an application for patent, a person to whom an inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may make application for patent on behalf of and as agent for all of the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §1.17(i), and the last known address of all of the inventors. 37 C.F.R. §1.47(b).

In accordance with 37 C.F.R. §1.47(b), Novactyl, Inc. ("Assignee"), assignee of the above-referenced patent application, through its Vice President and Chief Scientific Officer, Michael G. Douglas, respectfully requests authority to act on behalf of and as agent for all of the inventors. The inventor, Jose A. Fernandez-Pol assigned the invention claimed in the above-referenced patent application to Assignee in an assignment dated February 1, 2000, which is attached hereto. This assignment document was recorded in the U.S. Patent and Trademark Office on February 15, 2001 as reel/frame number 011602/0755.

Such action is necessary to preserve the rights of Assignee and to prevent irreparable damage to assignee. Under 37 C.F.R. §1.51(b) an oath or declaration must be filed with a specification prescribed by 35 U.S.C. §112, including a claim and drawings when necessary to complete a patent application. If an oath or declaration is not filed, the patent application will go abandoned resulting in irreparable damage and a loss of Assignee's rights under patent.

The inventor, Dr. Fernandez-Pol, was terminated from employment with Novactyl, Inc. in November of 2000. More recently, at Novactyl Inc.'s annual stockholder's meeting, which took place on June 2, 2001, Dr. Fernandez-Pol resigned from the Board of Directors. Since Dr. Fernandez-Pol's termination, he has been antagonistic to Assignee and its interests. As such, Dr. Fernandez-Pol has refused to participate in the prosecution of the above-referenced patent application. More specifically, Dr. Fernandez-Pol has refused to sign a declaration, which states that he is the inventor of the claimed invention.

On May 25, 2001, at the request of Dr. Fernandez-Pol, Assignee and Dr. Fernandez-Pol, along with their relative attorneys, met to discuss, among other topics, the status of the above-referenced patent application. At that time, the undersigned attorney for Assignee presented a declaration to Dr. Fernandez-Pol, which stated that he believed himself to be the inventor of the claimed invention and requested Dr. Fernandez-Pol's signature. It was explained to Dr. Fernandez-Pol at that time that no amendments had been made to the application since he assigned his rights to the invention to Assignee. In addition, a copy of the complete specification, including the claims, was provided to Dr. Fernandez-Pol. To date, Dr. Fernandez-Pol has refused to sign the declaration. The undersigned attorney for Assignee has made repeated unsuccessful attempts to obtain Dr. Fernandez-Pol's signature, which have included telephone calls to Gordon Sieckmann, attorney for Dr. Fernandez-Pol. On June 13, 2001 Mr. Sieckmann orally informed the undersigned attorney that Dr. Fernandez-Pol would not sign the declaration. On August 6, 2001 the undersigned attorney received a letter from

Mr. Sieckmann stating that Dr. Fernandez-Pol will not sign the requested supplemental oath. Again, if no declaration or oath is submitted, the application will go abandoned, which will result in a loss of Assignee's rights to the claimed invention and irreparable harm to Assignee. Most importantly, Assignee would lose the exclusive rights under patent to prevent others from making, using or selling its claimed invention for a limited time.

If Assignee is not authorized to sign on behalf of Dr. Fernandez-Pol, Assignee will suffer irreparable harm. Specifically, the time and revenue Assignee invested toward the research and development of the claimed invention would be lost. Assignee would also lose future income derived from the sale, use or manufacture of the invention. In addition, Assignee would lose potential revenue derived from licensing of Novactyl's rights in the invention.

In compliance with 37 C.F.R. §1.47(b), the last known address of the sole inventor, Jose A. Fernandez-Pol, is 437 Hunters Hill Drive, Chesterfield, MO 63017, USA.

The undersigned attorney may be reached at the address indicated below, by phone at (314) 552-6123, or by fax at (314) 552-7123.

Respectfully submitted,

Thompson Coburn LLP

By Ahaji K. Amos
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Enclosures: Letter from Gordon Sieckmann re: Dr. Fernandez-Pol's refusal to sign

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ARMSTRONG TEASDALE LLP

MISSOURI | KANSAS | ILLINOIS | WASHINGTON, DC | SHANGHAI | SYDNEY

ATTORNEYS AT LAW

August 6, 2001

TRANSMITTED BY FACSIMILE

Thompson Coburn LLP
One Mercantile Center
St. Louis, MO 63101

Attention: Ms. Ahaji Amos

Re: **A. U.S. Patent Application No. 09/677,500**
For: PHARMACOLOGICAL AGENT AND METHOD OF TREATMENT
Filed: 10/02/00
Your File No. 42108/25352
Inventor: Fernandez-Pol

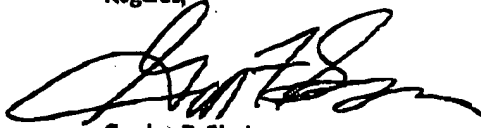
B. U.S. Patent Application No.
For: PHARMACOLOGICAL AGENT AND METHOD OF TREATMENT
Your File No. 42108/25508
Inventor: Fernandez-Pol

Dear Ms. Amos:

Thank you for your July 19, 2001 letter transmitting the Notice of Allowability and Issue Fee Transmittal for U.S. patent application (A) which I forwarded to our client Dr. Fernandez-Pol. Further, you requested a supplemental oath or declaration be executed by Dr. Fernandez-Pol for patent application (A). Previously, you requested a declaration be executed by Dr. Fernandez-Pol for (B).

Dr. Fernandez-Pol instructed our firm to notify you that he will not sign your requested supplemental oath for application (A), or the declaration for application (B). Dr. Fernandez-Pol said he has not received any information from your firm in response to our firm's May 10, 2001 letter to your firm advising your firm that changes are required in these patent applications (and any others). Additionally, Dr. Fernandez-Pol said that no communication has been provided from the U.S. Patent Office regarding the supplemental oath or declaration for (A).

Regards,



Gordon F. Sieckmann

GPS/s
cc: Mr. David Ott

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